

## **REMARKS**

### **I. Introduction**

Claims 13 to 28 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the acknowledgment that all certified copies of the priority documents have been received.

### **II. Objection to the Drawings**

The drawings were objected to under 37 CFR 1.83(a).

As regards the objection to the drawings, while 37 C.F.R. § 1.83(a) requires the drawings to show every feature specified in the claims, it also provides that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be” -- but are not required to be -- “illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation.” The features of a sliding bearing (5) lockable by a locking geometry, a cylindrical housing (1c), and one of (a) a second sliding bearing and (b) a sliding bushing (6) substantially covering a contact area arranged between a thrust member (4a, 4b) of the thrust member/pinion pairing and a housing part (1a, 1b) surrounding the thrust member need not be illustrated since a detailed illustration thereof is not essential for a proper understanding of the claimed subject matter. In addition, it is respectfully submitted that Figure 1 illustrates a partially cut-away, cross-sectional, two-dimensional view of the above features. Therefore, it is respectfully submitted that those of ordinary skill in the art would properly understand the above features disclosed in the description and the claims, without need for further illustration.

In view of all of the foregoing, withdrawal of the objection to the drawings is respectfully requested.

### **III. Rejection of Claims 13 to 28 Under 35 U.S.C. § 112, Second Paragraph**

Claims 13 to 28 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding claim 13, the Specification makes clear that a locking geometry “may be based on the lock geometry customary in sealing rings in automatic transmissions.” (Specification, p. 4, lines 11 to 12). Moreover, the Office Action appears to take issue with the breadth of claim 13. However, breadth of a claim is ***not*** to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 U.S.P.Q. 597 (C.C.P.A. 1971).

Regarding claim 16, the Specification makes clear that a second one of the two pinions “is connected to a sensor side ***or*** to a steering column.” (Specification, p. 6, line 15).

Regarding claim 22, while the rejection may not be agreed with, claim 22 has been amended herein without prejudice, thereby obviating the present rejection with respect to claim 22.

Accordingly, it is respectfully submitted that the present claims sufficiently “set forth and circumscribe a particular subject matter with a reasonable degree of clarity and precision,” which is all that is required under 35 U.S.C. § 112, second paragraph.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **IV. Rejection of Claims 13, 14, 17, 18, and 21 Under 35 U.S.C. § 102(b)**

Claims 13, 14, 17, 18, and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,828,068 (“Wendler et al.”). It is respectfully submitted that Wendler et al. do not anticipate the presently pending claims for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements

arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claim 13 relates to a rack-and-pinion electro-steering system, including, *inter alia*, a housing, at least one thrust member/pinion pairing, a rack extending in the housing, and at least one sliding bearing arranged between the rack and the housing to guide the rack, the sliding bearing lockable by a locking geometry, *the sliding bearing movable with the rack*.

Wendler et al. do not disclose, or even suggest, all of the claimed features of claim 13. Instead, Wendler et al. merely indicate “a stationary seal assembly 38 located within the power cylinder 30 [and] an outer bearing and seal assembly 40 closing the outer end of the power cylinder.” (Wendler et al., col. 2, lines 63 to 68). Both seal assemblies 38, 40 of Wendler et al. are plainly shown as stationary with respect to the housing 12. Thus, Wendler et al. do not disclose, or even suggest, the feature of *a sliding bearing movable with a rack*, as provided for in the context of claim 13. The Office Action appears to consider annular seal 29 to constitute a slide bearing. There is no indication by Wendler et al. that annular seal 29 corresponds to a slide bearing or whether the annular seal 29 is lockable by a locking geometry.

Moreover, the Office Action apparently recognizes that Wendler et al. does not disclose all of the features included in claim 13. For example, the Office Action states that main housing 12 described by Wendler et al. is assumed to be cylindrical, that main housing 12 is not shown to be honed and that at least one thrust member is not shown. A rejection under 35 U.S.C. § 102 cannot be sustained by assumptions or absence of disclosure. Rather, as indicated above, each and every feature of a claim must be found in the prior art in order to the prior art to be considered to anticipate a claim. The burden is on the Office to set forth a prima facie case of anticipation. The present Office Action is plainly deficient in this regard.

In view of the foregoing, it is respectfully submitted that Wendler et al. do not disclose, or even suggest, all of the features included in claim 13. As such, it is respectfully submitted that Wendler et al. do not anticipate claim 13.

As for claims 14, 17, 18, and 21, which depend from and therefore include all of the features included in claim 13, it is respectfully submitted that

Wendler et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 15, 19, and 20 Under 35 U.S.C. § 103(a)**

Claims 15, 19, and 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over Wendler et al. It is respectfully submitted that Wendler et al. do not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claims 15, 19, and 20 depend from claim 13. As more fully set forth above, Wendler et al. do not disclose, or even suggest, all of the features included in claim 13, from which claims 15, 19, and 20 depend. As such, it is respectfully submitted that Wendler et al. do not render unpatentable claims 15, 19, and 20, which depend from claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claim 16 Under 35 U.S.C. § 103(a)**

Claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wendler et al. and U.S. Patent No. 6,543,569 (“Shimizu et al.”). It is respectfully submitted that the combination of Wendler et al. and Shimizu et al. does not render unpatentable the presently pending claim for at least the following reasons.

Claim 16 depends from claim 13. As more fully set forth above, Wendler et al. do not disclose, or even suggest, all of the features included in claim 13. Shimizu et al. also do not disclose, or even suggest, all of the features included in claim 13, and thus, fail to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Wendler et al. and Shimizu et al. does not disclose, or even suggest, all of the features included in claim 13, from which claim 16 depends. As such, it is respectfully submitted that the combination of Wendler et al. and Shimizu et al. does not render unpatentable claim 16, which depends from claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **VII. Rejection of Claims 22 to 25 Under 35 U.S.C. § 103(a)**

Claims 22 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wendler et al. and U.S. Patent No. 5,622,085 (“Kostrzewa”). It is respectfully submitted that the combination of Wendler et al. and Kostrzewa does not render unpatentable the presently pending claims for at least the following reasons.

Claims 22 to 25 ultimately depend from claim 13. As more fully set forth above, Wendler et al. do not disclose, or even suggest, all of the features included in claim 13. Kostrzewa also does not disclose, or even suggest, all of the features included in claim 13, and thus, fails to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Wendler et al. and Kostrzewa does not disclose, or even suggest, all of the features included in claim 13, from which claims 22 to 25 ultimately depend. As such, it is respectfully submitted that the combination of Wendler et al. and Kostrzewa does not render unpatentable claims 22 to 25, which ultimately depend from claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **VIII. Rejection of Claims 26 to 28 Under 35 U.S.C. § 103(a)**

Claims 26 to 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wendler et al. and U.S. Patent No. 3,844,181 (“Bayle”). It is respectfully submitted that the combination of Wendler et al. and

Bayle does not render unpatentable the presently pending claims for at least the following reasons.

Claims 26 to 28 depend from claim 13. As more fully set forth above, Wendler et al. do not disclose, or even suggest, all of the features included in claim 13. Bayle also does not disclose, or even suggest, all of the features included in claim 13, and thus, fails to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Wendler et al. and Bayle does not disclose, or even suggest, all of the features included in claim 13, from which claims 26 to 28 depend. As such, it is respectfully submitted that the combination of Wendler et al. and Bayle does not render unpatentable claims 26 to 28, which depend from claim 13.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IX. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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